



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/748,889      | 12/27/2000  | Frederick W. Ryan JR. | F-212               | 5705             |

919 7590 09/21/2009  
PITNEY BOWES INC.  
35 WATERVIEW DRIVE  
MSC 26-22  
SHELTON, CT 06484-3000

|          |
|----------|
| EXAMINER |
|----------|

SHERR, CRISTINA O

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3685

|                   |               |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

09/21/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iptl@pb.com

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2  
3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* FREDERICK W. RYAN, JR.,  
9 THOMAS J. FOTH,  
10 CATHY C. MORRISSEY,  
11 STEVEN J. PAULY,  
12 and  
13 LEON A. PINTSOV  
14

15  
16 Appeal 2009-004868  
17 Application 09/748,889  
18 Technology Center 3600  
19

20  
21 Decided: September 18, 2009  
22

23  
24  
25 *Before:* MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH  
26 A. FISCHETTI, *Administrative Patent Judges.*  
27  
28 CRAWFORD, *Administrative Patent Judge.*  
29

30  
31 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 31. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented a mail piece verification system and method. (Spec. 1).

Claim 1 under appeal reads as follows:

1. A mail piece verification system for processing a mail piece in a path of travel, the mail piece having associated therewith mail piece data, the system comprising:
  - an incoming mail processing center for receiving the mail piece and obtaining the mail piece data, the incoming mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces;
  - an outgoing mail processing center located downstream in the path of travel from the incoming mail processing center, the outgoing mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces; and
  - a data center in operative communication with the incoming mail processing center and the outgoing mail processing center; andwherein:
  - the incoming mail processing center uploads the mail piece data to the data center;
  - the data center performs a verification check on the mail piece data and downloads instructions based upon the verification check to the outgoing mail processing center; and
  - the outgoing mail processing center uses the instructions to control operation of at least one of the mail processing machines located at the outgoing mail processing center to process the mail piece.

1 The prior art relied upon by the Examiner in rejecting the claims on  
2 appeal is:

|           |              |               |
|-----------|--------------|---------------|
| 3 Hunter  | US 5,280,531 | Jan. 18, 1994 |
| 4 Moore   | US 5,917,925 | Jul. 29, 1999 |
| 5 Fleming | US 5,953,710 | Sep. 14, 1999 |

6 The Examiner rejected claims 1 to 5 and 7 to 31 under 35 U.S.C. §  
7 103(a) as being unpatentable over Hunter in view of Moore.

8 The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being  
9 unpatentable over Hunter in view of Moore and Fleming.<sup>1</sup>

## 11 ISSUES

12 Have Appellants shown that the Examiner erred in rejecting claims 1,  
13 15, and 27 under 35 U.S.C. § 103(a) because Moore does not disclose  
14 instructions downloaded from a data center to control operation of a mail  
15 processing machine that performs automated processing of the mail pieces to  
16 process the mail piece?

17 Have Appellants shown that the Examiner erred in rejecting claims 4,  
18 7, and 13 under 35 U.S.C. § 103(a) because Moore does not disclose or  
19 teach the recitations in claims 4, 7, and 13?

20 Have Appellants shown that the Examiner erred in rejecting claims 5,  
21 8, and 11 under 35 U.S.C. § 103(a) because Hunter does not disclose or  
22 teach the recitations in claims 5, 8, and 11?

---

<sup>1</sup> The Examiner did not list Fleming in the Answer in the list of references or in the statement of the rejections. However, Fleming was included in the Final Rejection and the grounds of rejection in the Appeal Brief. The Answer states that Appellants' grounds of rejection in the Brief is correct. Therefore, we will consider the absence of Fleming in the Answer to have been inadvertent.

FINDINGS OF FACT

Hunter discloses an automatic mail piece verification system 40 that include an incoming mail processing center for receiving mail and an outgoing mail processing center located downstream in the path of travel of the incoming mail processing center (Fig. 1; col. 2, ll. 47 to 55; col. 3, ll. 6 to 24). The system 40 determines if the postage amount is a valid amount for the class of mail (col. 5, ll. 56 to 63). The system also diverts the mail piece to a diverter mechanism 30 if the postage amount is not correct by use of a control signal to activate the diverter mechanism (col. 5, ll. 64 to 68). Hunter discloses that mail data is input before the postage amount is checked (Fig. 2).

Moore discloses a plurality of mail processing machines that perform automated processing of mail pieces (col. 1, ll. 14 to 19; col. 9, ll. 59 to 67). A field reader is used to inspect the mail to determine whether the mail is correctly routed (col. 13, ll. 39 to 41). The process ensures that the mail piece is properly routed (col. 14, ll. 5 to 9). The field reader communicates with a local host computer 14 and the control computer 12 to authenticate marks on the mail piece and to track the mail piece (col. 13, ll. 17 to 23).

PRINCIPLES OF LAW

On appeal, Applicants bear the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of the prior art. Applicants may sustain their burden by showing that where the Examiner relies on a combination of disclosures, the Examiner failed to

1 provide sufficient evidence to show that one having ordinary skill in the art  
2 would have done what Applicants did. *United States v. Adams*, 383 U.S. 39,  
3 52 (1966).

4  
5 ANALYSIS

6 We are not persuaded by Appellants' arguments that the Examiner  
7 erred in rejecting claims 1, 15, and 27. The Examiner has made extensive  
8 factual findings in the Non Final Office Action dated May 18, 2007, with  
9 respect to the elements of these claims. The bulk of Appellants' arguments  
10 regarding the rejection of these claims merely restates the elements of the  
11 claim language and simply argues that the elements are missing from the  
12 Hunter reference. However, the Appellants do not explain why the  
13 Examiner's explicit findings are in error. As these arguments do not explain  
14 why the Examiner's findings are in error, we hold that these arguments do  
15 not establish error on the part of the Examiner. We note that arguments not  
16 presented by the Appellant in the brief are deemed waived unless good cause  
17 is shown as to why they were not presented. 37 C.F.R. § 41.37(c)(1)(vii)  
18 (2008).

19 In regard to the Appellants' argument that Moore does not disclose  
20 automated processing of mail pieces, a data center that downloads  
21 instructions to the outgoing mail processing center or a method that includes  
22 the step of downloading instructions to the outgoing mail processor, we note  
23 that an applicant cannot show non-obviousness by attacking references  
24 individually where, as here, the rejections are based on a combination of  
25 references. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). The Examiner  
26 has relied on Hunter not Moore for teaching these features of the claims.

1 In view of the foregoing, we will sustain the Examiner's rejection of  
2 claims 1, 15, and 27. We will also sustain this rejection as it is directed to  
3 claims 2, 3, 16, 17, 21, 28, and 29 dependent thereon because the Appellants  
4 have not argued the separate patentability of these claims.

5 We are not persuaded of error on the part of the Examiner by  
6 Appellants' argument that Moore does not disclose or teach the recitations in  
7 claims 4 and 7. The Examiner found that the subject matter of dependent  
8 claims 4 and 7 is disclosed in Moore at column 13, lines 30 to 55. The  
9 Appellants do not explain why this portion of Moore does not disclose the  
10 subject matter of claims 4 and 7 but only restates the recitations in the claims  
11 and state that Moore does not disclose the subject matter recited. Weighing  
12 these arguments which are not supported by further explanation against the  
13 Examiner's findings, we hold that the Appellants have not shown error in the  
14 Examiner's findings.

15 Further, as we found above, Moore discloses that a field reader, in  
16 communication with the local host computer and the control computer is  
17 used to inspect the mail to determine whether the mail is correctly routed  
18 and that the process ensures that the mail piece is properly routed. As such,  
19 Moore does disclose that the system determines a delivery route for the mail  
20 pieces and sends instructions to the particular outgoing mail center related to  
21 the mail piece.

22 Therefore, we will sustain the Examiner's rejection of claims 4 and 7.

23 We agree with the Appellants that the Examiner erred in rejecting  
24 claims 5, 8, and 11 because prior art does not disclose using the service class  
25 to establish priority for the upload of mail piece data. While Hunter  
26 discloses that the system checks to see if the postage amount is correct for

1 the class of mail, there is no disclosure that the class of mail is used to  
2 determine the priority for the upload of mail data. Indeed, Hunter discloses  
3 that mail data is input before the postage amount is checked. In addition,  
4 while Moore discloses that markings and indicia are used to determine  
5 whether the mail piece is correctly routed, Moore does not disclose that the  
6 class of the mail is used to prioritize upload of mail data.

7 Therefore, we will not sustain the Examiner's rejection of claims 5, 8,  
8 and 11, or claims 9 and 10 to 14 dependent thereon. We will also not sustain  
9 the rejection as it is directed to claims 18 to 20, 22 to 26, 30, and 31 because  
10 these claims also include the subject matter that the service class is used to  
11 establish a priority for a download of data.

12 We will also sustain the rejection of claim 6 under 35 U.S.C. § 103(a)  
13 as being unpatentable over Hunter in view of Moore and Fleming because  
14 claim 6 includes the subject matter that the service class is used to establish  
15 a priority for the download of data and Fleming does not cure the deficiency  
16 noted above for Hunter and Moore.

#### 17 18 CONCLUSIONS OF LAW

19 On the record before us, Appellants have not shown that the Examiner  
20 erred in rejecting claims 1 to 4, 7, 15, 16, 17, 21, and 27 to 29 under 35  
21 U.S.C. § 103(a). The Appellants have shown that the Examiner erred in  
22 rejecting claims 5, 6, 8 to 14, 18 to 20, 22 to 26, 30, and 31.



DECISION

The Examiner's rejection of claims 1 to 4, 7, 15, 16, 17, 21, and 27 to 29 is sustained. The Examiner's rejection of claims 5, 6, 8 to 14, 18 to 20, 22 to 26, 30, and 31 is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

hh

PITNEY BOWES INC.  
35 WATERVIEW DRIVE  
MSC 26-22  
SHELTON, CT 06484-3000